

REMARKS

At the outset, applicants would like to thank Examiner Robertson for his time and consideration of the present application at the interview of January 6, 2004 with the undersigned agent. At the interview, the issues raised in the outstanding Official Action were discussed.

In the outstanding Official Action, the disclosure was objected to under 35 USC §132. The Official Action alleged that the previous amendment introduced new matter into the disclosure. While applicants believe that the changes to the specification are fully supported by the disclosure, in the interest of advancing prosecution, the specification at page 3, lines 32-34 has been amended to recite "molar mass". As a result, applicants believe that this rejection has been obviated.

Claims 1-12 were rejected under 35 USC §112, first paragraph, for allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is respectfully traversed.

In imposing the rejection, the Official Action stated that the disclosure sets forth a range for the molecular weight of the siloxane. The Official Action alleged that it was not known how the molecular weight was determined and whether it was

weight average or number-average molecular weight. However, once again, applicants respectfully submit that this term would be known to one of ordinary skill in the art. Indeed, the Examiner's attention is respectfully directed to page 5, line 10, wherein the present specification cites to the WO 96/16109 publication. The specification states that the "Polysiloxanes described in WO 96/16109 can be generally used as a polysiloxane constituent of the resin component in the compositions of the invention." The Examiner's attention is also respectfully directed to the corresponding U.S. 5,618,860 and U.S. 5,804,616 patents. As a result, applicants believe that one of ordinary skill in the art would clearly be able to make and/or use the claimed invention.

Indeed, the Examiner is respectfully reminded that it is a well-founded principle that any assertion by the Patent Office that the enabling disclosure is not commensurate in scope with the protection sought must be supported by evidence or reasoning substantiating the doubts expressed. As a matter of law, the expressed teachings of a patent specification cannot be controverted by mere speculation and unsupported assertions on the part of the Patent Office. As stated by the Customs and Patent and Appeals in the case of *In re Dinh-Nguyen and Stanhagen*, 181 USPQ 46 (CCPA 1974):

Any assertion by the Patent Office that the enabling disclosure is not commensurate in scope but the protection sought must be supported by evidence

or reasoning substantiating the doubts expressed.
181 USPQ at 47.

Such a standard must be applied with great care when the conjecture by the Patent Office is contrary to the teachings of the specification. When reviewing the position of the Patent Office on this point, it is apparent that no evidence is provided that is inconsistent with the teaching of the specification that would support an allegation that the claims are not supported by the present disclosure. Indeed, the Official Action fails to explain why the teachings of the present application, the WO 96/16109 publication, the U.S. 5,618,860 patent and the U.S. 5,804,616 patent are insufficient.

As a result, applicants believe that claims 1-12 are fully supported by the present disclosure.

Claims 1, 3, and 9-11 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by KURIYAMA et al. 4,851,481. This rejection is respectfully traversed.

Applicants believe that KURIYAMA et al. fail to disclose or suggest the claimed invention. As the Examiner is aware, the claimed invention is directed to a composition that contains a resin constituent that comprises a non-aromatic epoxy resin, a polysiloxane, and an epoxy silane which acts as a crosslinking agent between the epoxy and siloxane chains.

KURIYAMA et al. do not disclose or suggest that these components should be present together in a resin constituent.

For example, while Example 10 may disclose the use of glycidoxypropyltrimethoxysilane, it is not in combination with a non-aromatic epoxy resin but rather bisphenol A (an aromatic compound). As a result, the claimed combination is never fully disclosed. Applicants respectfully submit that KURIYAMA et al. fail to anticipate the claimed invention.

Moreover, while KURIYAMA et al. may disclose an epoxy resin composition, applicants believe that KURIYAMA et al. teach that the reaction product of polysiloxane and organosilane (which does not have to be an epoxy silane) is mechanically dispersed and that the epoxy resin does not take part in a hardening reaction.

Moreover, a particle size range has been defined by KURIYAMA et al. for the reaction product. Applicants believe that this indicative of the fact that the reaction product does not react on a molecular level or take part in a hardening reaction. As a result, applicants believe that KURIYAMA et al. fail to disclose an epoxy silane which acts as a crossover region between siloxane chains.

At this time, the Examiner's attention is respectfully directed to the declaration by Mika Peralá. The declaration presents the results of comparative tests carried out between the present invention and KURIYAMA et al. The declaration shows that the composition of the present invention exhibits improved clarity, viscosity, curing properties and UV-resistance

properties. As a result, applicants believe that the declaration demonstrates that the present invention exhibits unexpected results.

Thus, it is believed that KURIYAMA et al. fail to anticipate or render obvious the claimed invention. Claims 1, 2, 9, 10 and 12 were rejected as allegedly being anticipated by GASMENA 5,703,178. This rejection is respectfully traversed.

GASMENA discloses a coating composition that must be prepared by combining an epoxy silane resin, an epoxy resin, a silicone intermediate, a silicone-modified polyether, an amino silane, at least one organometallic catalyst, at least one organic solvent, water, and at least one filler. As a result, GASMENA does not explicitly recite the claimed composition. It is believed that GASMENA fails to anticipate the claimed invention.

Applicants also believe that GASMENA fails to render obvious the claimed invention. The Examiner's attention is respectfully directed to column 4, line 64 to column 5, and line 20, wherein GASMENA teaches that the use of a silicone containing polyether is required. In the formula presented in column 5, R7 represents a hydrocarbon. The chain is formed of oxygen and hydrocarbon. GASMENA does not teach polysiloxane of the claimed invention.

The GASMENA publication provides no motivation or suggestion that the publication should be modified in a manner to

obtain the claimed combination of components. Moreover, the publication certainly does not indicate that the combination of the claimed components would exhibit such unexpected and improved properties as identified above.

Thus, it is believed that GASMENA fails to anticipate or render obvious the claimed invention.

In the outstanding Official Action, claims 4 and 5 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over KURIYAMA et al. in view of EKLUND et al. 6,180,726. This rejection is respectfully traversed.

EKLUND et al. fail to disclose or suggest the claimed combination of components. As a result, it believed that EKLUND et al. fail to remedy the deficiencies of KURIYAMA et al.

Thus, it is believed that the proposed combination fails to render obvious claims 4 and 5.

Claims 4, 6, and 7 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over KURIYAMA et al. in view of IWAMURA et al. 5,705,567. This rejection is respectfully traversed.

It is believed that IWAMURA et al. fail to remedy the deficiencies of KURIYAMA et al. IWAMURA et al. neither teach nor suggest the claimed combination. Moreover, the publication provides no motivation to modify the publication to obtain the claimed invention. Indeed, there is no indication in IWAMURA et al. that the claimed combination of ingredients could be used to

provide the improved and unexpected results exhibited by the claimed invention.

Thus, it is believed that the proposed combination fails to render obvious the claimed invention.

Claims 3-5 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over GASMENA in view of EKLUND et al. This rejection is respectfully traversed.

As noted above, EKLUND et al. and GASMENA et al. both fail to disclose or suggest the claimed invention. The combination neither teaches the claimed combination of components nor provides the necessary motivation to combine and modify the publications to obtain the claimed invention.

Thus, in view of the above, it is believed that the present combination of GASMENA in view of EKLUND et al. fails to render obvious claims 3-5.

Claims 3, 4, 6, and 7 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over GASMENA in view of IWAMURA et al. This rejection is respectfully traversed.

It is believed that IWAMURA et al. fail to remedy the deficiencies of GASMENA. IWAMURA et al. do not teach nor suggest the claimed combination. Moreover, the publication provides no motivation to modify the publication to obtain the claimed invention. Indeed, there is no indication in IWAMURA et al. that the claimed combination of ingredients could be used to provide

the improved and unexpected results exhibited by the claimed invention.


Thus, it is believed that GASMENA in view of IWAMURA et al. fails to render obvious claims 3, 4, 6, and 7.

In view of the present amendment and the foregoing remarks, therefore, it is believed that this application is now in condition for allowance, with claims 1-12, as presented. Allowance and passage to issue on that basis are accordingly respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON



Philip Dubois, Reg. No. 50,696
745 South 23rd Street
Arlington, VA 22202
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709

PD/lrs

APPENDIX:

The Appendix includes the following item:

- declaration by Mika PERÄLÄ